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EXAMINER

JONES, SCOTT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,508

Applicant(s)

NEWDELMAN, MITCHELL J.

Examiner

Scott E. Jones

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/20/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on October 20, 2003 in which applicant amends claims 1, 7, 8, 9, 13, 15, 16, 17, 21, 22, and 28, amends the specification and title, and responds to the claim rejections. Claims 1-29 are pending.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- Display (100) is not shown in figure 2 as described on page 12, line 8 of the specification.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities:

Art Unit: 3713

- On page 12, line 17, “man” should be changed to “many”.
- The sentence on page 14, lines 2-3 should be reviewed and amended to be more clear.

Correction is required.

Claim Objections

5. Claim 29 is objected to because of the following informalities:

- In claim 29, the last line, “of” between “greater” and “lesser” should be changed to “or”.

Correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-20 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, nowhere in the specification or drawings is “pre-designating the game as a high or low game” disclosed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3713

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 21-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by

Friedman (U.S. 6,457,715).

Friedman discloses a method for playing a card or other type of wagering game on a card table or in an electronic video gaming machine wherein a player places a wager and a dealer deals two cards to the player. Instead of cards, other indicators selected or dealt from a set of indicators including a plurality of indicators bearing indicia designating a series of ordered rank, such as dice, or numbered tokens may be employed. The player is then afforded the opportunity to inspect the two cards and discard and replace zero, one, or two of the cards. After the discard option, the dealer reveals a third card and resolves the player's wager dependent on whether a predetermined winning relationship exists between the first, second, and third cards. Friedman additionally discloses:

Regarding Claim 21:

- a video display (Column 2, lines 14-21 and Claim 14).
- a processor including a data structure storing data corresponding to game indicia (Column 2, lines 14-21 and Claim 14);
- means for the player to enter a wager to play at least two game hands simultaneously (Figure 2 and Claim 14);
- means for the player to prompt play of the game, said processor in response to prompting play selecting from the data structure (playing cards) and controlling the

Art Unit: 3713

display to display at least two game indicia for each hand and an outcome indicia (exposed card) and comparing the value and other characteristic of the outcome card to each of the game indicia for each hand (Figure 2 and Claim 14);

- means for rewarding the player based upon the wager for each hand if the outcome card is determined to be one of a greater value than any same suited game cards (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14).

Regarding Claim 22:

- means for the player to select for at least one hand at least one of the indicia of a hand for replacement, said processor programmed to select from the data structure and display a replacement indicia for the indicia selected for replacement (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14).

Regarding Claim 23:

- said processor programmed to select from the data structure said game indicia, means for the player to select a game indicia for at least one hand for replacement and prompt play, said processor in response to prompting of play selecting from the data structure and displaying at the display a replacement indicia for the indicia selected for replacement and to select from the data structure said outcome indicia.

Regarding Claim 24:

- displaying four game indicia (split hand) (Figure 2 and Column 2, lines 50-54).

Regarding Claim 25:

Art Unit: 3713

- presenting for each hand an outcome indicia (exposed card) (Column 2, line 56-Column 3, line 5).

Regarding Claim 29:

- a player making a wager to play each of a plurality of game hands (Figure 2 and Column 2, lines 50-54); If a player receives two cards with the same rank, then the player can split the hand and receive two additional cards to make two separate hands.
- presenting from an inventory of at least one deck of playing cards, a plurality of game cards for each hand, each card having a value and a suit, said dealing depleting said inventory (Column 2, lines 8-10); A standard deck of fifty-two cards can be used to play the game, therefore, as cards are dealt and replaced, the inventory (remaining cards in the deck) are depleted.
- the player selecting for at least one game hand a card for replacement and replacing each selected card from and depleting the inventory of cards, no game or replacement card replicated in any game hand (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14);
- selecting and displaying from said inventory an outcome card and comparing the outcome card to the game cards of each hand, the player winning their wager if the outcome card has one of a greater or lesser value than any of the same suited game cards (Abstract, Figure 2, Column 1, lines 39-50, Column 2, line 22-Column 3, line 35, and Claims 1, 13, and 14).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. 6,457,715) in view of Richardson (U.S. 5,813,673).

Friedman discloses to one having ordinary skill in the art that as discussed above regarding claims 21-25 and 29. Additionally, Friedman discloses:

Regarding Claim 2:

- presenting for each hand an outcome indicia (exposed card) (Column 2, line 56-Column 3, line 5).

Regarding Claims 5, 11, and 15:

- prior to presenting the outcome card (exposed card), the player discards and receives a replacement for at least one card (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14).

Regarding Claims 6 and 12:

- displaying four game indicia (split hand) (Figure 2 and Column 2, lines 50-54).

Regarding Claims 16 and 20:

- a video display (Column 2, lines 14-21 and Claim 14).
- a processor including a data structure storing data corresponding to game indicia (Column 2, lines 14-21 and Claim 14);

Art Unit: 3713

- means for the player to enter a wager to play at least two game hands simultaneously (Figure 2 and Claim 14);
- means for the player to prompt play of the game, said processor in response to prompting play selecting from the data structure (playing cards) and controlling the display to display at least two game indicia for each hand and an outcome indicia (exposed card) and comparing the value and other characteristic of the outcome card to each of the game indicia for each hand (Figure 2 and Claim 14);
- means for rewarding the player based upon the wager for any hand if the outcome indicia is determined to be one of a pre-programmed lesser or greater value than any game indicia of the hand having the same set characteristic (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14).

Regarding Claim 17:

- means for the player to select for at least one hand at least one of the indicia of a hand for replacement, said processor programmed to select from the data structure and display a replacement indicia for the indicia selected for replacement (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14).

Regarding Claim 18:

- said processor programmed to select from the data structure said game indicia, means for the player to select a game indicia for at least one hand for replacement and prompt play, said processor in response to prompting of play selecting from the data structure and displaying at the display a replacement indicia for the indicia selected

Art Unit: 3713

for replacement and to select from the data structure said outcome indicia (Column 1, lines 39-50, Column 2, lines 22-45, Column 3, lines 5-10, and Claims 1, 13, and 14).

Friedman seems to lack explicitly disclosing:

Regarding Claims 1, 9, 13, 16, and 28:

- pre-designating the game as a high or low game.

Regarding Claims 13, 19, 26, and 27:

- each hand consists of four game cards having a value and suit.

Richardson, like Friedman, teaches of a high-low card game which is adapted to private and casino gambling. Therefore, Richardson and Friedman are analogous art. Richardson also teaches a card game using a standard fifty two card deck of four suits being played by dealing a plurality of cards to each player. Richardson teaches of an "E" card, equivalent to Friedman's "exposed card", which is dealt single face up to the dealer. The object of the game is for the players to have at least one card which is of a higher (or lower, as decided by each player before any cards are dealt) rank than the "E" card and of the same suit. However, Richardson lacks teaching of the ability for a player to play a plurality of hands. Richardson additionally teaches:

Regarding Claims 1, 9, 13, 16, and 28:

- pre-designating the game as a high or low game (Abstract and Column 3, lines 56-66).

Regarding Claims 13, 19, 26, and 27:

- each hand consists of four game cards having a value and suit (Column 4, lines 10-11 and 18-19, and Claim 2).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to modify Friedman's high-low game with the features disclosed in Richardson's high-low game. One would be motivated to do so because pre-designating a game to be a high or low game would enable the player to choose what the game they feel in that moment they will win, adding excitement to the game. Also, one would be motivated to deal four cards for each hand to each player in order to increase the odds of obtaining a winning hand making the game more fun to the players.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,575,828. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to incorporate multiple hands in the game as discussed above regarding Friedman.

Response to Arguments

14. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments, see page 3 of the response, filed October 20, 2003, with respect to the abstract have been fully considered and are persuasive. The objection of abstract has been withdrawn.

16. Applicant's arguments, see page 2, filed October 20, 2003, with respect to the title have been fully considered and are persuasive. The objection of the title has been withdrawn.

17. Applicant's arguments, see page 2, filed October 20, 2003, with respect to the specification have been fully considered and are persuasive. The objection of the specification has been withdrawn.

18. Applicant's arguments, see pages 7-8 and 14-15, filed October 20, 2003, with respect to the rejection to claims 17 and 21-25 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection to claims 17 and 21-25 under 35 U.S.C. 112, second paragraph has been withdrawn.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sklar '573 discloses a method for playing a plurality of high-low games.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713



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